Appl. No. 09/997,269
Amdt. dated **November 4, 2003**
Reply to Office Action of July 16, 2003

PATENT

REMARKS/ARGUMENTS

Claims 19-33 have been added and claims 1-18 remain unchanged. Thus, claims 1-33 are pending.

Claims 1-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (USP 6,549,894) in view of MacPhail (USP 5,107,419).

As amended, all the pending claims of the subject application comply with all requirements of 35 U.S.C. Accordingly, Applicant requests examination and allowance of all pending claims.

Formal Matters

Applicants filed an IDS on March 6, 2003 for the present application and have received a stamped postcard from the USPTO indicating that this IDS was properly received. Accordingly, Applicants respectfully request that the Examiner consider each of the references cited in the IDS during the prosecution of this application and that an appropriate copy of the PTO 1449 form accompanying the IDS be returned to Applicants with the Examiner's initials next to each reference so considered.

The Rejection Under 35 U.S.C. 103(a)

Claims 1-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (USP 6,549,894) in view of MacPhail (USP 5,107,419). Applicants respectfully assert that a *prima facie* case of obviousness has not been established for any of the claims and that this rejection is respectfully traversed.

A.   Claims 1-10:

With respect to the rejection of claim 1 the Examiner argues that Simpson discloses "storing a plurality of documents related to a patent application in a database accessible to a server system, wherein each of said plurality of documents has a document type and wherein said plurality of stored documents includes at least one document having a first document type and at least one document having a second document type". In support of this statement the Examiner refers to col. 2, lines 1-55 and col. 4, lines 34-67 of Simpson. See Office Action, page 2.

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Applicants have reviewed these sections in detail and have reviewed the entire Simpson patent and disagree with the Examiner's conclusion. Simpson is directed to a computerized docketing system that tracks due dates associated with legal matters such as patent applications. It is clear that the docketing system disclosed in Simpson stores information related to the legal matters being tracked as well as due dates associated with actions that need to be taken on the tracked matters (see e.g., col. 3, lines 36-41) but there is no indication anywhere in Simpson that the docketing system also stores documents of any kind yet alone documents related to a patent application as recited in claim 1. If the Examiner disagrees with this conclusion, it is respectfully requested that the Examiner explicitly point out what in the Simpson reference corresponds to the first and second plurality of electronic documents recited in claim 1.

The secondary reference, MacPhail, does not make up for this deficiency. Accordingly, Applicants respectfully assert that the Section 103 rejection set forth in the Office Action has been traversed.

Additionally, while Applicants appreciate the Examiner's acknowledgement that Simpson does not teach other aspects of the invention including "storing a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type" (see Office Action, page 3), Applicants respectfully assert that MacPhail also does not teach or suggest such. The Examiner states "MacPhail teaches that it is known to store a rule in said database that indicates specific document types to be deleted from said database in response to a predetermined event occurring related to a document, wherein said rule indicates that documents of said second type should be deleted but not documents of said first type." Office Action, page 3. No specific reference is made to any part of the MacPhail patent, however, for this teaching.

Applicants have reviewed the MacPhail reference in detail and respectfully assert that MacPhail does not teach "storing a rule that indicates specific document types to be deleted" as recited in claim 1. Instead, MacPhail teaches that documents can be retained or deleted by setting document expiration dates for different labels associated with the documents. The system in MacPhail then compares a document's expiration dates with the current system date in order to

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determine if a specific documents should be deleted or retained. See e.g., col. 4, lines 1-4. The only rules disclosed by MacPhail are rules that calculate the expiration date as discussed with respect to Figs. 12a, 12b and 13a-13d. See col. 10, lines 1-41. Such rules do not delete documents based on a document type associated with the document as required by claim 1. If the Examiner disagrees, it is respectfully requested that the Examiner explicitly point out what in the MacPhail reference corresponds to the rules recited in claim 1.

From the above discussion it is evident that the MacPhail reference does not teach or suggest what the Rejection states it teaches and that the Simpson and MacPhail references cannot combine to make the invention of claim 1 obvious to a person of skill in the art. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection of claim 1 and its dependent claims, claims 2-10.

Applicants further assert that the rejection of each of the dependent claims is deficient. 37 CFR §1.104(c)(2) states that the pertinence of each reference must be clearly explained when rejecting a claim. See also MPEP §707 and §707.05 (when prior art is cited its pertinence should be explained). The present Rejection of claims 2-10 does not meet this requirement of the CFR. Instead, in rejecting each of these claims the Examiner references a section of the Simpson reference as teaching one or more of the elements recited in each dependent claim but makes no explanation at all as to the relevance of the referenced section. Applicants have reviewed the rejection of each dependent claim and cannot determine how the Examiner is applying the reference against the claim. For example, with respect to claim 3, what in the Simpson references corresponds to the "client system" recited in the claim and what corresponds to the "signal" recited in the claim; with respect to claim 4, how does a system that does not even store documents keep track of the type of such nonexistent documents; what corresponds to the "signal" recited in claim 7; what corresponds to the "third document type" recited in claim 8 and the "fourth document type" recited in claim 9. Without any explanation whatsoever of the relevance of the Simpson reference to each of these dependent claims, Applicants assert that a *prima facie* case of obviousness has not been established for any of the claims.

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B.   Claims 11-15:

Similar to claim 1, claim 11 also requires storing a plurality of electronic documents related to a patent application. Simpson does not teach or suggest this element of the claims as discussed above. Accordingly, Applicants respectfully assert that rejection of claim 11 is improper.

Claim 11 also recites a number of other elements not recited in claim 1 including, for example, that each of the stored electronic documents has an attribute associated with it and that a rule is stored that deletes documents based on the value of this attribute. The Rejection states that these elements of claim 11 are taught by Simpson as discussed with respect to claim 1. See Office Action, pages 6-7. Claim 1 does not recite any of these elements, however, and the Rejection does not explain the pertinence of Simpson towards these claimed features. Accordingly, Applicants assert that, for this additional reason, a *prima facie* case of obviousness has not been established with respect to claim 11.

Applicants further assert that the rejection of each of the claims that depend from claim 11 is deficient because the pertinence of the Simpson reference to each claim is not explained in the Rejection. Applicants assert that a *prima facie* case of obviousness has not been established for any of the claims for this additional reason.

C.   Claims 16-18:

Claim 16 is an apparatus claim that requires a processor, a database and a program stored in a memory that operates to store an invention disclosure, a patent application and unofficial documents related to the patent application in the database. As discussed above, Simpson does not disclose such an apparatus. To the extent that Simpson discloses a docketing system that includes a database that stores docketing information there is no disclosure in Simpson that the database also stores an invention disclosure, a patent application and unofficial documents related to the patent application as required by claim 16. Furthermore, contrary to what is stated in the Rejection, neither Simpson or MacPhail disclose a program that operates to "receive an instruction to categorize said patent application as allowed and automatically delete said unofficial documents related to the paten application" as recited in claim 16. If the Examiner disagrees, it is respectfully requested that the Examiner explicitly point out what in either the Simpson or MacPhail reference corresponds to the recited instruction.

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In view of the above it is evident that the Simpson and MacPhail references cannot combine to make the invention of claim 16 obvious to a person of skill in the art. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection.

Applicants further assert that the rejection of each of the claims that depend from claim 16 is deficient because the pertinence of the Simpson and/or MacPhail references to each claim is not explained in the Rejection. For example, claim 17 recites that the claimed processor is operative with the claimed program to allow a client system to set-up "workflow rules related to defining specific types of documents to be deleted and/or specific types of documents to be saved in response to receiving an instruction that a patent application has been allowed." The Rejection states that this limitation is taught by Simpson at col. 7, lines 14-34 and by MacPhail at col. 1, lines 55-67 and col. 2, lines 1-3.

The referenced portion of Simpson discloses how docketing due dates can be tracked in a spreadsheet. There is no disclosure within that portion of Simpson, or any where else in the reference for that matter, of the claimed workflow rules. Similarly, the referenced portions of MacPhail discloses that document retention and deletion strategies are desirable and that decisions to keep or delete a document may be more complicated than the prior art systems known to the MacPhail inventors allowed for. At best MacPhail suggests that decisions to delete documents may be made based on document types. It does not teach or suggest, or combined with Simpson to teach or suggest that workflow rules may be developed that define types of documents to be deleted from a database in response to receiving an instruction that a patent application has been allowed. Accordingly, Applicants respectfully assert that a *prima facie* case of obviousness has not been established for claim 17 or claim 18, which depends from claim 17, for at least this additional reason.
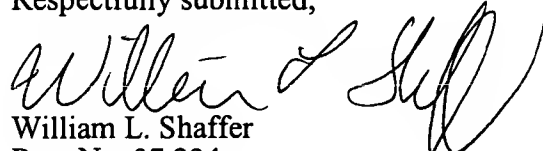
New Claims 19-33

New claims 19-33 have been added to secure an appropriate scope of protection for the present application. It is respectfully asserted that none of the new claims are taught or suggested by the prior art. Examination and allowance of the claims is requested.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

William L. Shaffer
Reg. No. 37,234

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 650-326-2400 / Fax: 415-576-0300
WLS/ka
60008869 v1